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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,577	01/10/2007	Fabrice Pinard	294013US6PCT	2725
22850 7590 09/01/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MCNALLY, DANIEL				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
09/01/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/589,577

Applicant(s)

PINARD, FABRICE

Examiner

DANIEL MCNALLY

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/4/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8, 11, 12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9, 10, 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1, 2, 4-7, 9, 10, 13, 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the negative limitation of "without redrawing..." which is not supported by the specification. The applicant's failure to explicitly recite a redrawing step in the specification does not support the negative limitation excluding the redrawing step from the method. Claims 2, 4-7, 9, 10, 13, 15 and 16 depend from claim 1 and are rejected for the same reason.

Claim 20 recites the negative limitation of "without redrawing..." which is not supported by the specification. The applicant's failure to explicitly recite a redrawing step in the specification does not support the negative limitation excluding the redrawing step from the method.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-6, 9, 10, 13, 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa et al. [US5653357, of record, previously cited, herein "Miyazawa"] in view of Saunders [US5590558, of record, previously cited, herein "Saunders"].

Miyazawa discloses a method of making a laminate part. The method comprises providing a steel sheet with a thickness from .1-.5mm (column 6, lines 27-67), providing a film of adhesive polymers with a thickness of about .1mm (column 8, lines 20-21), laminating the sheet with the film (column 9, lines 32-35), the laminated sheet has a total thickness which is the sum of the individual layer thicknesses, the laminate is drawn by a tool comprising a punch, die and annular holding member (column 9, lines 22-31; column 9, line 66 - column 10, line 9). Miyazawa discloses forming a drawn article without re-drawing. Miyazawa discloses using a conventional drawing method but is silent as to adjusting the value of the material passage.

Saunders discloses a method of draw processing a can. The method comprises a conventional draw practice along with preselecting a tool clearance at least about the thickness of the coated can stock, which eliminates any thickening of side wall metal during the cupping operation (column 6, lines 14-21; column 9, lines 33-40).

It would have been obvious to one of ordinary skill in the art to modify the method of Miyazawa by using a tool with a tool clearance at least about equal to the thickness of the material being drawn as taught by Saunders in order to eliminate any thickening of side wall metal during the drawing operation. Because the clearance or "material

passage" is at least about equal to the thickness of the material being drawn, the claimed equation is satisfied.

With regard to claim 2, Miyazawa discloses the steel material is coated with the polymer film on what will be the inside surface of a formed container, and the punch is directly applied to the side of the steel material that is the inside surface, therefore the punch is directly contacted to the side of the steel material that is coated with the polymer film.

With regard to claim 4, Miyazawa discloses providing a steel sheet with a thickness from .1-.5mm.

With regard to claim 5, Miyazawa discloses the thickness of the polymer film is about 0.1mm, and it would have been well within the purview of one of ordinary skill in the art to use a polymer film with a thickness greater than 0.2mm. Optimization of the polymer film thickness can be performed by one of ordinary skill to balance shock resistance, workability and flavor retentively, by ordinary experimentation.

With regard to claim 6, Miyazawa discloses the total thickness of the laminate steel sheet is between 0.3 and 1.2mm.

With regard to claim 9, Miyazawa discloses the polymer film is a thermoplastic.

With regard to claim 10, Miyazawa discloses the polymer film is polyester.

With regard to claim 13, Miyazawa discloses performing a surface treatment to the surface of the steel sheet to improve adhesion with the polymer film.

With regard to claim 16, the claim is directed toward the intended use of the final article and does not limit the method steps of producing the final article. Therefore the

method of Miyazawa as modified satisfies all of the required limitations of the method claim.

With regard to claim 17, applicant is referred to the discussion above. Additionally Saunders discloses a tool clearance at least about the thickness of the coated can stock. "At least about the thickness of the coated can stock" includes a tool clearance that is slightly less than thickness of the coated can stock, which satisfies the requirement of the claim.

With regard to claim 19, the claim is directed toward the intended use of the final article and does not limit the method steps of producing the final article. Therefore the method of Miyazawa as modified satisfies all of the required limitations of the method claim.

With regard to claim 20, Miyazawa discloses a method of forming a drawn article without re-drawing.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa, Saunders, and further in view of Shimizu [US5686194, of record, previously cited].

Miyazawa as modified discloses a method of forming a laminated part. Applicant is referred to paragraph 3 for a detailed discussion of Miyazawa as modified. Miyazawa discloses extruding the polymer film and laminating the polymer film to the steel sheet, but is silent as to directly extruding the polymer film to the steel sheet.

Shimizu discloses a method of forming a laminated part. The method comprises laminating a polymer film to a steel sheet. Shimizu discloses using one or a

combination of process for laminating the polymer film to the sheet. Shimizu discloses the film can be formed and then laminated to the steel sheet or directly laminating the polymer film to the steel sheet (column 7, lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Miyazawa by directly laminating the polymer film to the steel sheet as taught by Shimizu as a well known alternative to forming and laminating the polymer film. A substitution of well known alternatives is within the purview of one of ordinary skill.

5. Claims 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa, Saunders and further in view of either one of Ullman, Jr. [US4354370, newly cited, herein "Ullman"] or Ueno et al. [US4143790, newly cited, herein "Ueno"].

Miyazawa as modified discloses a method of forming a laminated part. Applicant is referred to paragraph 3 for a detailed discussion of Miyazawa as modified. Miyazawa discloses drawing a blank, Saunders discloses a blank of a preselected diameter can be cut from the stock material (column 3, lines 56-60). Miyazawa is silent as to the blank having a dimension greater than 600mm. The requirement of the article being an external automotive body part does not limit the method of forming the article.

However in the event that the requirement of the article being an external automotive body part does limit the method, Ullman discloses blanks can be drawn into articles useful as sinks, tubs, automobile fenders and the like (column 3, lines 39-43),

and Ueno discloses blanks can be drawn into articles useful as can bodies, casings of electrical instruments and armoring of vehicles (column 8, line 59 - column 9, line 2).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Miyazawa to make an article useful as an external automotive body part as taught by either one of Ullman or Ueno in order to use the known method to inexpensively produce the desired shaped part. One of ordinary skill in the art would readily appreciate that an automobile fender would be formed of a part that includes a dimension larger than 600mm.

6. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa, Saunders, either one of Ullman or Ueno, and optionally further in view of Rashid et al. [US6253588, newly cited, herein "Rashid"].

Miyazawa as modified discloses a method of forming a laminated part. Applicant is referred to paragraph 5 for a detailed discussion of Miyazawa as modified. Miyazawa as modified discloses forming an external automotive body part. In the event that it is not obvious that the blank used to form the body part would include a dimension larger than 600mm. Rashid discloses a method of forming an external automotive body part from a blank. The blank is 47 inches by 70 inches in size (column 5, lines 29-31).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Miyazawa to use a blank that has a dimension larger than 600mm as optionally taught by Rashid in order to form a body panel of sufficient size to fit the final automobile.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 4-7, 9, 10, 13, and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues claim 1 requires performing the method without a redrawing step, and that Saunders teaches a redrawing step. Firstly Miyazawa does not require a re-drawing step, and the first drawing step of Saunders with the clearance about equal to the thickness of the can stock can produce a drawn article without a re-drawing step. Saunders is cited to teach the clearance for the drawing step, and is not cited to modify Miyazawa to include a re-drawing step. The re-drawing step of Saunders is not essential to the first drawing step. Therefore one of ordinary skill would appreciate the method would comprise the drawing step of Miyazawa with a clearance taught by Saunders without a re-drawing step. Secondly, the claim requires forming a composite laminate part that is drawn, the intermediate produce formed by Saunders after the drawing step and before the re-drawing steps, is considered a composite laminate part that is drawn.

Applicant's arguments to Fujimoto are moot as the rejection in view of Fujimoto has been withdrawn.

Applicant argues new claim 17 requires the material passage is less than the total thickness according the formula found in the claim, and that Saunders teaches a clearance that is equal to the material thickness. Saunders discloses the clearance is at least *about* the thickness of the material (column 9, lines 34-40). This language of

Saunders broadly includes a clearance that is slightly smaller than the material thickness.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANIEL MCNALLY** whose telephone number is (571)272-2685. The examiner can normally be reached on Monday - Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel McNally/
Examiner, Art Unit 1791

/John L. Goff/
Primary Examiner, Art Unit 1791

DPM
August 25, 2009